

Remarks

Claims 1-27 are pending. Reconsideration is respectfully requested.

The Restriction Requirement

In response to the Office Action dated March 8, 2007 requiring restriction election, Applicants provisionally elect with traverse Group III (claims 1-2, 11-23, and 25-27). Reconsideration and withdrawal of said restriction requirement are respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis.

The Alleged Groups

The Action alleges that the following Groups are related as subcombinations (MPEP § 806.05(d)) and are distinct from each other:

- I. Claims 1, 3-4, and 25-26, with claims 1 and 25-26 alleged to be generic.
- II. Claims 1-2, 5-10, and 24-26, with claims 1-2 and 25-26 alleged to be generic.
- III. Claims 1-2, 11-23, and 25-27, with claims 1-2 and 25-26 alleged to be generic.

The Restriction Requirement is not legally proper because there is no serious burden

MPEP § 803 sets forth criteria for a proper election requirement. One of the criteria is that there must be a serious burden on the Examiner in order for election to be required. Conversely, if the search and examination of an entire application can be made without serious burden on an Examiner, then it must be examined on the merits. Applicants respectfully submit that the requirement is not legally proper because the criteria for serious burden has not been met.

The Restriction is improperly based on incorrect Group definitions

The Action indicates that Group II is directed to “a platen for supporting a transport” and Group III is directed to “a removable portable dispensing cassette”. However, the Group II claims neither mention nor are directed to “supporting a transport”. Likewise, the Group III claims neither mention nor are directed to a “dispensing cassette” or any “cassette”. Thus, the relied upon Group definitions are incorrect. On this basis alone the restriction requirement is legally improper and should be withdrawn.

As best understood, the restriction requirement is meant for an application other than Applicants' application. Thus, Applicants respectfully submit that the restriction requirement should be withdrawn from their application and applied to the other (correct) application.

The Office has not shown the alleged Groups to be distinct

The burden is on the Examiner to provide valid examples. If Applicants prove or provide an argument that the Examiner's suggested other use cannot be accomplished or is unreasonable, then the burden is on the Examiner to document a viable alternative use or withdraw the requirement. MPEP § 806.05 (d). Applicants respectfully submit that the Office has not met its required burden. Each separate utility alleged by the Office is unreasonable, as discussed herein.

The Action also has not provided the required showing of distinct subcombinations. The Action is absent a showing that the alleged subcombinations do not overlap in scope, are not obvious variants, and are separately usable. For example, the Office has not shown that each alleged subcombination I, II, and III is separately usable (i.e., can be used without its generic claim). The Office misinterprets and misapplies the meaning of “separately usable.” Nor has the Office shown two-way distinctness.

Group I

The alleged separate utility (blocking dispensing through a dispensing outlet) for Group I is unreasonable and legally improper. The record lacks evidence of any blocking dispensing through a dispensing outlet in a cash dispensing system ("blocking dispensing").

Furthermore, claim 8 of Group II also has a blocking gate. Therefore, even if it were somehow possible for the Office to show that "blocking dispensing" is a reasonable utility for Group I, the Office still couldn't show that the alleged Group I has separate utility from Group II. If Group I has the utility of "blocking dispensing" as alleged, then what specific language in Group II would prevent its use with "blocking dispensing" (the alleged utility uniquely attributed to Group I)? There isn't any such specific language in Group II. Thus, restriction between Groups I and II is legally improper.

The Office has not shown the alleged subcombinations to be separately usable. It follows that the Office has not shown the alleged subcombinations to be distinct. As the Office has not met its legal burden, the restriction requirement is improper and should be withdrawn.

Group II

The alleged separate utility (moving conveying documents to an alternate dispensing port) for Group II is unreasonable and legally improper. The record lacks evidence of such utility.

Furthermore, the Office has not shown that moving conveying documents to an alternate dispensing port is a utility uniquely attributed to Group II. What specific language in Group I (or Group III) prevents its use with moving conveying documents to an alternate dispensing port? There isn't any. Thus, restriction between Groups II and I (and Groups II and III) is legally improper.

Group III

The alleged separate utility (providing a vessel for relocating checks between locations remotely controlling equipment and communicating to satellite dispensers) for Group III is unreasonable and legally improper. The record lacks evidence of such utility.

Furthermore, the Office has not shown that providing a vessel for relocating checks between locations remotely controlling equipment and communicating to satellite dispensers ("providing a vessel") is a utility uniquely attributed to Group III. Claim 24 of Group II also has a vessel. Therefore, even if it were somehow possible for the Office to show that "providing a vessel" is a reasonable utility for Group III, the Office still couldn't show that the alleged Group III has separate utility from Group II. If Group III has the utility of "providing a vessel" as alleged, then what specific language in Group II would prevent its use with "providing a vessel" (the alleged utility uniquely attributed to Group III)? There isn't any such specific language in Group III. Thus, restriction between Groups III and II is legally improper.

Conclusion

As previously discussed, the Office has not provided a showing that the alleged subcombinations are separately usable. It follows that the Office has not shown the alleged subcombinations to be distinct. Furthermore, Applicants have proven that the Office's attempted restrictions between Groups I/II and between Groups II/III are *prima facie* legally improper due to similar features being recited in the related Groups (i.e., the alleged subcombinations overlap in scope). Applicants have shown that the Office has not met its legally required burden for imposing a restriction. Thus, the improper restriction requirement should be withdrawn.

The criteria applied for restriction requirement is legally improper

The Action alleges that Groups are related as subcombinations. MPEP § 806.05(d) sets forth the criteria needed to allege distinct subcombinations. The initial criteria requires that claims be directed to separately claimed plural *subcombinations* and a separately claimed *combination*. The original claims 1-27 do not permit this criteria to be met. Where do Applicants' claims include both a combination claim and subcombination claims?

Rejoinder

The Examiner's acknowledgment that "Several claims are subject to rejoinder contingent upon their dependence from an allowable base claim" (paragraph number 6) is appreciated. Also, once a generic claim is allowable, all claims being either dependent thereon or including the allowable subject matter will likewise be allowable.

The Restriction Requirement Is Without Legal Basis

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being "distinct." The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both "independent" and "distinct." The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

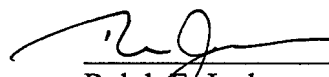
In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not shown that the claims directed to Applicants' invention are unrelated in design, operation, and effect. Thus, the statutory requirements have not been met and no restriction requirement may be imposed.

Conclusion

For all the foregoing reasons it is respectfully submitted that there is no valid basis for the restriction requirement. Applicants respectfully request that the requirement be withdrawn.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000